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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,603	08/04/2005	Toyozo Fujioka	262807US0PCT	8526

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EXAMINER

TESKIN, FRED M

ART UNIT PAPER NUMBER

1713

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/517,603

Applicant(s)

FUJIOKA, TOYOZO

Examiner

Fred M. Teskin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 7 and 8 is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 6 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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The Reply of June 6, 2006, has been fully considered with the following effect:

(i) The Section 112 rejection and the objection under Rule 75(c) have been obviated by appropriate amendments to claims 1-5;

(ii) The prior art rejection based on Nishimura et al is withdrawn in view of applicants' arguments directed to solvent level and copolymer softening point, see page 5 of the Reply;

(iii) The prior art rejections based on Daughenbaugh et al and GB '989 are maintained and applicants' arguments found unpersuasive as detailed below;

(iv) Claims 2, 7 and 8 are allowable over the prior art of record;

(v) Claims 4 and 5 are objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 6 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5739239 to Daughenbaugh et al.

The rejection is maintained for the reasons of record (see p. 5 of the prior Office action) and those which follow.

Claims 1 and 6 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 1377989.

The rejection is maintained for the reasons of record (see p. 6 of the prior Office action) and those which follow.

Applicants' arguments filed June 6, 2006 have been fully considered but are not persuasive of error in the repeated rejections.

With respect to Daughenbaugh et al and GB '989, applicants' arguments are essentially two-fold: (1) neither reference teaches, recognizes, or suggests the use of divisional addition of the monomer mixture to the solvent and controlling the quantity of solvent during thermal polymerization and (2) accordingly, the polymers are different.

As to point (1), applicants do not dispute that the examples of Daughenbaugh et al and GB '989 cited by the examiner describe the use of solvent levels within claims 1 and 3. Indeed, Samples 2 and 8 (Table 1) and 1-6 (Table 6) of Daughenbaugh et al and Run Nos. 4, 7, 8, 18, 21 and 22 of GB '989 describe copolymers having the requisite softening point and made by heat polymerizing dicyclopentadiene and a vinyl-

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substituted aromatic using solvent at a level within the ranges of claims 1 and 2, as amended. While neither references teaches or suggests divisional addition of the monomer mixture to the solvent, this process limitation has not been related to any unobvious difference in the ultimate product to which claims 1, 3 and 6 are directed.

It is well settled that product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

In view of the identity of copolymer softening point and composition as well as mode of polymerization (thermal) and solvent level, the product of claims 1, 3 and 6 is considered the same as or only slightly and unobviously different from the products of Daughenbaugh et al and GB '989.

As to point (II), the assertion of different polymers stands unsupported by objective evidence in the record. In particular, applicants' comparative examples (Specification, Tables 1 and 2) purport to compare the effect of adding solvent in an amount within and outside the claimed range. However, the cited examples of Daughenbaugh et al and GB '989 each describe the use of solvent in an amount *within the claimed range* to obtain copolymer having a softening point within the ranges of claims 1 and 3. The comparative evidence fails to demonstrate that the applicants'

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copolymer product is substantively different from the copolymers of the closest prior art as a result of divisional addition of the monomer mixture to the solvent during preparation.

As applicant has not met the burden of coming forward with evidence establishing an unobvious difference between the claimed products and the prior art products, *In re Marosi*, 218 USPQ 195 (Fed. Cir. 1983), the continued rejection of claims 1, 3 and 6 is still deemed tenable and therefore must be maintained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

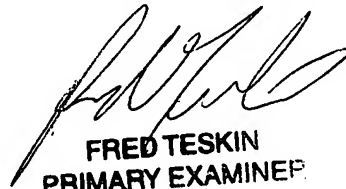
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FRED TESKIN  
PRIMARY EXAMINER  
1713

FMTeskin/08-16-06